

REMARKS

No claims are amended. No new claims are added. Claims 1-42 and 48-70 are cancelled without prejudice. Claims 43-47 are pending for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

Allowable Subject Matter

In the present action, the Office indicates that claims 43-47 are allowable except for a rejection under 35 U.S.C. § 112, 2nd paragraph. Applicant thanks the Office the indication of allowable subject matter.

§ 112 Rejection

Claim 43 stands rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office states that the Applicant uses a negative limitation in the claim as follows: "wherein at least some of the parameters do not depend on..." The Office then suggests that Applicant should incorporate a positive limitation within the claim that specifies what parameters do depend on.

Applicant has researched the issue of negative limitations extensively and can find no authority which proscribes the use of a negative limitation in a claim. In the particular context of this claim, there is nothing unclear or indefinite about the negative limitation that is utilized in the claim. Specifically, this claim recites, in pertinent part, "wherein at least some of the parameters do not depend on any

1 message that is conveyed by any content of an email message". In the context of
2 the specification, it is abundantly clear what is meant by this term.

3 Further, the MPEP provides instruction that is particularly on point in this
4 regard. As an example, consider MPEP § 2173.01 which instructs as follows:

5 A fundamental principle contained in 35 U.S.C. 112, second
6 paragraph is that applicants are their own lexicographers. They can
7 define in the claims what they regard as their invention essentially in
8 whatever terms they choose....Applicant may use functional
9 language, alternative expressions, *negative limitations*, or any style
10 of expression or format of claim which makes clear the boundaries
11 of the subject matter for which protection is sought. As noted by the
12 court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA
13 1971), a claim may not be rejected solely because of the type of
14 language used to define the subject matter for which patent
15 protection is sought.

16 In addition, MPEP § 2173.05(i), entitled "Negative Limitations" instructs
17 as follows:

18 The current view of the courts is that there is nothing inherently
19 ambiguous or uncertain about a negative limitation. So long as the
20 boundaries of the patent protection sought are set forth definitely,
21 albeit negatively, the claim complies with the requirements of 35
22 U.S.C. 112, second paragraph. Some older cases were critical of
23 negative limitations because they tended to define the invention in
24 terms of what it was not, rather than pointing out the invention.
25 Thus, the court observed that the limitation "R is an alkenyl radical
other than 2-butenyl and 2,4-pentadienyl" was a negative limitation
that rendered the claim indefinite because it was an attempt to claim
the invention by excluding what the inventors did not invent rather
than distinctly and particularly pointing out what they did invent.

In *re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). A claim
which recited the limitation "said homopolymer being free from the
proteins, soaps, resins, and sugars present in natural Hevea rubber"
in order to exclude the characteristics of the prior art product, was

1 considered definite because each recited limitation was definite. In
2 re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641
3 (CCPA 1970). In addition, the court found that the negative
4 limitation "incapable of forming a dye with said oxidized developing
5 agent" was definite because the boundaries of the patent protection
6 sought were clear. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA
7 1971).

8 Any negative limitation or exclusionary proviso must have basis in
9 the original disclosure. If alternative elements are positively recited
10 in the specification, they may be explicitly excluded in the claims.
11 See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA
12 1977) ("[the] specification, having described the whole, necessarily
13 described the part remaining."). See also Ex parte Grasselli, 231
14 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir.
15 1984). The mere absence of a positive recitation is not basis for an
16 exclusion.

17 In view of the above discussion, Applicant respectfully submits that there is
18 nothing inappropriate or indefinite with regard to the use of a negative limitation
19 in this claim. To the contrary, there is ample support in the case law and guidance
20 set forth by the MPEP that clearly supports and sanctions the use of negative
21 limitations in claims.

22 As such, Applicant respectfully traverses the Office's rejection.

23 Conclusion

24 Applicant respectfully submits that all pending claims are in condition for
25 allowance. Accordingly, Applicant requests that a Notice of Allowability be
issued. If the Office's next anticipated action is to be anything other than issuance
of a Notice of Allowability, Applicant requests that the undersigned be contacted
for the purpose of scheduling an interview.

Respectfully submitted,

Dated:

6/2/05By: 

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